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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,399	01/14/2004	Craig E. Newman	RIC-02-010	3507

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EXAMINER

NGUYEN, QUYNH H

ART UNIT	PAPER NUMBER
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2614

NOTIFICATION DATE	DELIVERY MODE
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03/07/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/756,399	NEWMAN ET AL.	
	Examiner	Art Unit	
	QUYNH H. NGUYEN	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/14/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The indicated allowability of claims 1-10 and 17-22 is withdrawn in view of newly discovered reference(s). Rejections based on the newly cited reference(s) below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 23, claims the non-statutory subject matter of a computer program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). For example, in Applicant's Specification stating the computer-readable media includes transmission media can take the form of acoustic or light waves, punch cards, paper tape, carrier wave (see paragraphs [0029] and [0030]). Therefore, since the claimed instructions are not

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tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

Claims 24-26 are rejected because they depend on rejected claim 23.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 8-10, and 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pershan (US Patent 6,865,266).

As to claim 1, Pershan teaches the steps of:

establishing a call from an originator in a first address space outside of the IP address space to an IP device within the IP address space (col. 5, lines 27-31 and lines 61-64; col. 12, lines 28-39; col. 14, lines 18-22);

sending, from the IP device, a message to a switch in the first address space indicating a new destination in the first address space (col. 15, lines 18-19; col. 12, line 60 through col. 13, line 36; col. 14, lines 35-45 - *where Pershan discussed a telephone call originating from the PSTN to an IP device in a VoIP network 104, the call being transferred from the PSTN network to the VoIP network, it is inherent that when one pushes the transfer button and dial the number, a message/trigger is sent to the switch*).

Pershan does not explicitly teach releasing the established call; and establishing a second call from the originator in the first address space to the new destination in the first address space.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that once the called party transfers the originator's call it releases the original established called and establishing the call from the transferred device to the called party. This feature is notoriously well known in the art of call transferring telecommunications network and the advantage of using it is also well known.

As to claim 2, Pershan teaches the first address space includes a PSTN network (Fig. 1, PSTN 102).

As to claim 3, Pershan teaches establishing of the call is performed via an IP gateway configured to bridge the first address space and the IP address space (col. 6, lines 28-65).

As to claims 4, 19-20 and 24, Pershan teaches the IP gateway communicate using SS7 Protocol within the first address space and a SIP within the IP address space, the IP telephony gateway translating received messages between the SS7 Protocol and the SIP protocol (col. 6, line 54 through col. 7, line 8; col. 15, lines 5-30).

As to claim 8, Pershan teaches the IP device includes at least one of an IP proxy and an IP client (col. 10, lines 11-19).

As to claims 9 and 22, Pershan teaches call progress messages are passed between the originator and the IP device (col. 12, line 45 through col. 13, line 36).

As to claim 10, Pershan teaches determining by the IP device the destination based on information provided from the originator (col. 8, lines 42-45).

Claim 17 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Pershan teaches a gateway (Fig. 1, IP gateway switch 122); an IP device configured to send message to the gateway (col. 10, lines 20-29).

As to claims 18 and 21, Pershan teaches the IP device is configured to include billing information (see abstract; col. 7, lines 9-26; col. 10, lines 6-11).

Claims 23 and 25 are rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Pershan teaches translating the request for the call from a first protocol to a second protocol (col. 6, line 54 through col. 7, line 8; col. 15, lines 5-30) and inserting the indication of the originator into the message (col. 3, lines 7-16; col. 4, line 58 through col. 5, line 13; col. 6, lines 54-65).

As to claim 26, Pershan does not explicitly teach releasing call resources when a message indicating termination of the call is received from one of the address spaces. It would have been obvious to one of ordinary skill in the art at the time the invention was made that once the called party transfers the call it releases the original established call and establishing the call from the transferred device to the called party. This feature is notoriously well known in the art of call transferring telecommunications network and the advantage of using it is also well known.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pershan (US Patent 6,865,266) in view of O'Connor et al. (US Patent 7,313,131).

As to claim 5, Pershan teaches data filed added to a call by switches used to forward (col. 4, line 66 through col. 5, line 13), Pershan does not explicitly teach a SIP REFER message from the IP device to the IP telephony gateway, the SIP REFER message including an indication of the destination.

O'Connor teaches a SIP REFER message from the IP device to the IP telephony gateway, the SIP REFER message including an indication of the destination (col. 2, lines 8-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that SIP REFER message is created to replace the "to:" field including the SIP address of the new location. This is notoriously well known in the processing of Session Initiation Protocol request messages and the advantage of using this message is also well known.

As to claim 6, Pershan teaches sending the IP telephony gateway a SS7 message including the indication of the destination and a circuit identification code from the call from the originator, the CIC being saved by the IP gateway during the establishing of the call from the originator to the IP device through the IP gateway (col. 4, line 58 through col. 5, line 13; col. 12, lines 35-65).

As to claim 7, Pershan teaches the message includes information for billing within a PSTN switch (see abstract; col. 7, lines 9-26).

Allowable Subject Matter

7. Claims 11-16 are allowed.

Response to Arguments

8. Applicant's arguments filed 12/14/07 have been fully considered but they are not persuasive.

Regarding the 101 rejection, Applicant amended claims 23-26 from "medium" to "memory device". First of all, the specification does not disclose what memory device is. Secondly, there is no different between medium and memory device. Furthermore, in the specification paragraphs [0029] and [0030], Applicant discloses computer readable media as light waves, punch cards, paper tape, and carrier wave. Therefore, since the claimed instructions are not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101, and the rejection is maintained.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quynh H Nguyen/

Primary Examiner, Art Unit 2614